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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,532	09/10/2003	Victor Bota	116719.00010	4798

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EXAMINER
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MAZZUCA JR, DOUGLAS

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,532	<b>Applicant(s)</b> BOTA, VICTOR	
	<b>Examiner</b> Douglas E. Mazzuca	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/09/2003</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to an apparatus for forming a reducer/expander duct member, classified in class 29, subclass 796.
  - II. Claim 18, drawn to a method for forming a reducer/expander duct member, classified in class 29, subclass 429.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed could be practiced by a materially different apparatus such as an apparatus that does not have a housing containing a first and second workstation.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Robert Clark on 2/6/06 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claim 18 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

1. The disclosure is objected to because of the following informalities:

On page 7, paragraph 22, the "base plate" is referred to as 196, yet, throughout the specification, and also in the drawings, the "base plate" is commonly referred to with the number 96.

On page 7, paragraph 22, the "annular slots" are referred to as 197, yet, throughout the specification, and also in the drawings, the "annular slots" are commonly referred to with the number 97

Appropriate correction is required.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a circular channel 82 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-8, and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bota (US Patent No. 6,105,227). Concerning claims 1, 6, 11, 12, and 14, bota discloses the following:

An apparatus for forming a reducer/expander duct member for use in an air handling system comprising (**column 1 lines 5-8**): a housing comprising a first workstation and a second workstation (**column 5 lines 1-3, and 15-17**); the first work station comprising a channel for accommodating a first cylindrical work piece of a first diameter and a first positioning member for aligning a frustoconical work piece for coupling to the first cylindrical work piece; the second work station comprising a channel for accommodating a second cylindrical work piece of a second diameter and a second positioning member for aligning a frustoconical work piece for coupling to the second cylindrical work piece (**column 10 lines 14-16**), a first die associated with said first work station which is selectively positioned at a predetermined location relative to said frustoconical work piece and the first cylindrical work piece positioned in said first work station, a second die associated with said second work station which is selectively positioned at a predetermined location relative to said frustoconical work piece and the second cylindrical work piece positioned in said second work station, wherein said first and second dies are different sizes adapted to accommodate different diameters of the first and second cylindrical work piece (**column 9 lines 51-62; column 7 lines 18-25**), a first coupling assembly associated with said first work station which cooperates with said first die to selectively couple the frustoconical work piece and the first cylindrical work piece, and a second coupling assembly associated with said second work station which cooperates with said second die to selectively couple the frustoconical work piece and the second cylindrical work

piece (**column 9 line 63-column 10 line 9**). Said coupling being performed by a die (**64 and 66 in figure 8, exerting a force by hydraulic ram 77**) and a rotating head (**144**) having at least one coupling bead wheel (**149**), in both workstations (**column 8 line 66-column 9 line 5**).

4. Regarding claims 2,3, 15 and 16, Bota discloses a positioning member in both workstations having at least a partially conical section (**Figure 8, 66 and 64**).

5. Concerning claim 7, Bota discloses a clamping system to properly position and secure the workpiece in a predetermined position (**column 8 lines 1-10**).

6. Concerning claim 8, Bota discloses a base plate at the bottom of each insertion channel of the first and second workstation (**column 5 lines 59-62**).

7. Concerning claim 13, the first positioning member (**64 and 66 of figure 8**) is rotatably connected to the rotating head (**144**) such that the first positioning member may remain stationary while the rotating head is rotating (**column 9 lines 21-23**).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-5,9-10 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bota (US Patent No. 6,105,227). In regard to claims 4-5, 9, and 17, it is inherent that Bota teaches an ejection system because the workpiece is removed from the first workstation (**column 6**

**lines 62-66).** This is done either by hand or mechanical means (**column 5 line 65-  
column 6 line 2; column 8 lines 32-33**). Alternatively, official notice is taken that it is well known to one of ordinary skill in the art, at the time of the invention, to provide an ejection system from the workstation either by hand or mechanical means. Hydraulic ejection systems in dies, either by use of pins or pistons, have been well known.

10. Concerning claim 10, the particular features of the work piece do not further limit the structural features of the claimed apparatus and therefore has been given no patentable weight. Alternatively, official notice is taken that it is well known to one of ordinary skill in the art, at the time of the invention, that air ducts and pipes take on many shapes and sizes and are therefore subject to different angles of cut.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas E. Mazzuca whose telephone number is (571)272-7813. The examiner can normally be reached on 7:30AM-4PM Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Jimenez can be reached on (571)272-4530. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Mazzuca  
February 9, 2006

DEM

  
**MARC JIMENEZ**  
**PRIMARY EXAMINER**  
2/13/06